Supreme Court of the United States

OCTOBER TERM, 1944

No. 1100

RICHARD A. ENGLER,

Petitioner,

v.

GENERAL ELECTRIC COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

CARL E. RING,
Attorney for Petitioner.

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CASES CITED

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PETITION FOR WRIT OF CERTIORARI

To the Honorable, the Chief Justice and Associate Justices of the SUPREME COURT OF THE UNITED STATES:

Your petitioner, Richard A. Engler, having been granted leave to prosecute this action in forma pauperis, by order of the District Court for the Southern District of New York and counsel having been duly appointed for petitioner by said court, prays for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review the decree of that Court in this cause filed January 4, 1945.

Summary Statement of the Matter Involved

This is a suit in equity by the petitioner in the Southern District of New York to recover damage for infringement of petitioners patent No. 1492972 issued May 6, 1924. The action was commenced in 1939 but was not tried until after counsel had been appointed for petitioner in 1941.

The District Court found petitioners patent not infringed, made no finding on validity of the patent and dismissed the complaint.

The Circuit Court of Appeals affirmed but there is not a strict concurrence of decision of both courts which would invoke the usual rule of this court to follow the lower courts as will appear hereinafter.

QUESTION INVOLVED

This Court has held in a long line of decisions that a combination patent may be valid, i.e., a combination of old elements combined in a new way to produce a new result. And, this court has repeatedly held that such a patent is infringed by a combination which omits one or more of the elements of ingredients of the combination—provided that each omitted element or ingredient is replaced by another which serves the same function in the combination *and was old* and well known as such a substitute or equivalent before the date of invention or application for patent.

In *Imhaeuser* v. *Buerk,* 101 U. S. 647, this court said:

> "Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents by which is meant that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which in the same arrangement of the parts, will perform the same function, *if it was well known as a proper substitute for the one described in the specifications at the date of the patent.*"

Other cases are cited in the brief.

Petitioners case falls squarely within this rule. The District Court held that there was no equivalent notwithstanding that appellees own expert witness, a Harvard professor, testified to the contrary.

The Court of Appeals in its original opinion likewise held there was no equivalent. After the testimony of Pro-

fessor Dawes, appellees expert, was pointed out to the court on an application for rehearing the court denied rehearing but recognized the equivalent in fact and function. Nevertheless the court held that there could be no equivalent in law because the substantial element was old and well known prior to petitioners invention.

The Court of Appeals said:

> "Thus the equivalency in function was recognized but we were unable to treat this as enough to come within the range of equivalents to which the patentee was entitled because, as we pointed out, what we called intermittent polarity *was old in the art.* We still are unable so to broaden the claim for the same reason, for whether the creation of poles of opposite value around the defendant's armature ought to be called a reversal of polarity or *not it is nevertheless an old feature as to which the appellant could not, and did not, obtain any monopoly when his patent was granted. So he must be limited in his range of equivalents* at least enough to exclude that."

Thus the Court of Appeals used as a ground for denying a favorable finding of equivalence and accordingly infringement the very fact which is the basis of a favorable rule as stated in the decisions of this court to wit: that the substituted element or ingredient was old and well known as a substitute to accomplish the same function prior to petitioners invention.*

Notwithstanding that petitioner had to go through a ten day trial and a long appeal and rehearing, this simple issue

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* The equivalent element was referred to as (5) in the Trial Court's opinion. The Circuit Court of Appeals also said element (10) was omitted but the District Court opinion had pointed out that if the ruling on element (5) was favorable, a favorable ruling on (10) would have to follow. This is discussed in full in the accompanying brief.

is now and always has been the only issue on infringement in this case and the pre-trial order of Judge Knox so provided.

WHEREFORE, your petitioner respectfully prays for a writ of certiorari to be issued under the seal of this Court directed to the United States Court of Appeals for the Second Circuit, commanding said Court to certify and send to this Court on a day to be designated a true and complete transcript of the record and proceedings of the Circuit Court of Appeals had in that Court, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals to be reversed; and that petitioner be granted such other and further relief as may be proper.

RICHARD A. ENGLER.

New York City,
March 31, 1945.